No. 00-1543

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

FESTO CORPORATION,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD.,
a/k/a SMC Corporation, and SMC Pneumatics, Inc.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF *AMICUS CURIAE* OF THE CHAMBER OF COMMERCE OF THE UNITED STATES IN SUPPORT OF THE PETITION

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BRIEF *AMICUS CURIAE* OF THE CHAMBER OF COMMERCE OF THE UNITED STATES IN SUPPORT OF *CERTIORARI*

This brief *amicus curiae* is respectfully submitted in support of *certiorari* pursuant to Rule 37.2.[1]

INTEREST OF *AMICUS CURIAE*

The Chamber of Commerce of the United States of America (the "Chamber"), a non-profit corporation organized and existing under the laws of the District of Columbia, is the largest federation of business, trade and professional corporations in the United States. The Chamber represents an underlying membership of more than three million businesses and organizations, with 140,000 direct members of every size, in every business sector, and from every geographic region of the country. An important function of the Chamber is to represent the interests of its members by filing amicus briefs in cases involving issues of national concern to American business.

The Chamber believes that the more than 1,200,000 United States patents in force and in process — a large percentage of them held by American businesses — are a critical part of the nation's capital base. These patents and the Patent System's ability to encourage future invention are key elements in America's future competitiveness in a global

1. Pursuant to Rule 37.6, *Amicus Curiae* states that no counsel for a party authored this brief in whole or in part, and no person or entity other than *Amicus Curiae*, its counsel and members made a monetary contribution to the preparation or submission of the brief. This brief is filed with the consent of the parties. Written consents will be filed concurrently with this brief.

economy increasingly driven by intellectual property. The Chamber recognizes that the value of these patent assets depends entirely on their enforceability by judicial process and is committed to ensuring an available, equitable and meaningful enforcement regime throughout the world. The Chamber also recognizes that the scope of patent protection must be reasonable so as not to suppress legitimate competitive innovation or unduly limit competition and Chamber members find themselves as both plaintiffs and defendants in patent infringement actions.

The decision of the Federal Circuit in this case substantially modifies a century and-a-half-old balance struck by this Court between the interests of patent owners and those of competitor-innovators. The decision significantly changes settled expectations, the value of existing patent portfolios and incentives for investment and innovation; it also encourages practitioners to modify their patent prosecution practices in ways that will greatly affect the functioning of the patent system. Nevertheless, the decision provides only a limited legal, equitable or economic foundation for the changed rule.

Given the longstanding involvement of this Court in shaping the doctrine of equivalents, the gravity of these issues and the deep division within the Federal Circuit reflected in the opinions below, the Chamber believes that the serious and weighty arguments advanced on both sides of this controversy warrant review and final resolution by this Court.

REASONS FOR GRANTING THE WRIT

I. THE FEDERAL CIRCUIT DECISION WILL SERIOUSLY AFFECT THE VALUE OF EXISTING PATENTS

A. The Decision Below Significantly Changes Settled Expectations Regarding Patent Enforceability And The Value Of Existing Patents.

After more than 50 Federal Circuit decisions to the contrary in the last 18 years, and 150 years of contrary teachings from this Court, the Federal Circuit's divided and "utterly unpredictable" *en banc* decision in *Festo Corp. v. Shokestu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 619 (Fed. Cir. 2000) (Michel, J., concurring-in-part and dissenting-in-part), imposed a new and retroactive rule requiring patent infringement to be proved literally whenever a patent claim has been amended for any reason relating to any statutory criterion for obtaining a patent. The Federal Circuit majority effected this change by expanding the concept of "prosecution history estoppel" to foreclose patent coverage for any and all equivalents to amended claim elements without regard to whether surrender of equivalent subject matter was necessary to the patent grant or intended by the applicant. *Id.* at 586. In doing so, it converted an equitable doctrine, designed to foreclose patent holders from benefitting by taking inconsistent positions on the scope of their patent claims before the Patent and Trademark Office (PTO) and the Courts, into an inflexible limitation into the scope of more than 1,200,000 U.S. patents in force and in process.

The prior rule followed by the Federal Circuit since its inception and by this Court for more than a century was that the doctrine of equivalents applied to an amended claim, even one amended to avoid prior art, as well as an unamended claim. An applicant was estopped, however, from recovering under the doctrine of equivalents subject matter actually surrendered during patent prosecution to secure issuance of the claim. *See, e.g., Hughes Aircraft Co. v. United States*, 717 F.2d 1351 (Fed. Cir. 1983) ("*Hughes I*"); *Litton Sys. Inc. v. Honeywell Inc.*, 140 F.3d 1449, 1455 (Fed. Cir. 1998) ("The common practice of amending a claim during prosecution, even amending to overcome prior art, does not necessarily surrender all subject matter beyond the literal scope of the amended claim limitation.") (Both overruled by the decision below).

The standard for determining what was surrendered in applying prosecution history estoppel was held by the Federal Circuit to be "an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent." *Hoganas AB v. Dresser Indus., Inc.*, 9 F.3d 948, 952 (1993); *see also Litton Sys. Inc.*, 140 F.3d at 1462 (The scope of subject matter surrendered by an amendment extended to "that which was deemed unpatentable in view of prior art" and "trivial variations of such prior art features.").

The *Festo* majority imposed a new rule. It held that if a claim were narrowed by amendment, the amended claim could not be infringed except by a literally exact copy of the claim elements affected by the amendment, unless the patentee demonstrated from the prosecution history record in the PTO that the amendment was unrelated to any aspect

of the statutory requirements of patentability. *Festo*, 234 F.3d at 586. Because the statutory requirements of patentability extend beyond distinguishing over prior art to matters such as definiteness of claim language, disclosure of the best mode, enablement, and written description, the new rule is likely to encompass virtually all amendments, whether or not significant in the prosecution. *Id.* at 566.

Patent applications are routinely amended during the examination process.[2] By ruling that amendments automatically surrender everything but their literal terms, the Federal Circuit majority substantively restricted the doctrine of equivalents, which was recently and unanimously re-endorsed by this Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997), and has been fundamental to the U.S. patent system for a century-and-a-half.[3] Equivalence protection under *Festo* is fully available

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2. As the Federal Circuit itself has observed, "[a]mendment of claims is a common practice in prosecution of patent applications," and "comparatively few claims [are] allowed exactly as originally filed. . . ." *Hughes I*, 717 F.2d at 1363; *accord Festo*, 234 F.3d at 638 n.3 ("[F]or simple inventions, at most 10-15% of patents are granted without claim amendment. . . . For complex inventions the percentage of unamended applications is vanishingly small.") (Newman, J., concurring-in-part and dissenting-in-part). Amendments are not infrequently submitted to add clarity, rather than narrow scope, and thus avoid an indefiniteness rejection.

3. The rationale for covering equivalents was described in practical terms by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950):

> [T]o permit imitation of a patented invention which does not copy every literal detail would be to convert the

(Cont'd)

only in the relative handful of instances where there was no amendment of the claims during patent prosecution.

While this Court, in *Warner-Jenkinson Co.*, 520 U.S. at 33, established a *rebuttable* presumption that an amendment was for a purpose related to patentability when the prosecution history contained no explanation of the reason for the amendment, the majority below made this presumption effectively *irrebuttable*. It held that only evidence from the prosecution history, which must be silent on the reason for the amendment before the presumption arises, can be used as evidence to rebut the presumption. "[T]he majority's ruling makes rebuttal impossible. . . ." *Festo*, 234 F.3d at 632 (Newman, J, concurring-in-part and dissenting-in part).

(Cont'd)

> protection of the patent grant into a *hollow and useless thing*. Such a limitation would leave room for — *indeed encourage* — the unscrupulous copyist to make *unimportant and insubstantial* changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention . . . may be expected to introduce minor variations to conceal and shelter the piracy. *Outright and forthright duplication* is a dull and *very rare type of infringement*. To prohibit no other would place the inventor *at the mercy of verbalism* and would be subordinating substance to form. It would deprive him of the *benefit of his invention* and would *foster concealment* rather *than disclosure* of inventions, which is one of the primary purposes of the patent system. (Emphasis added).

This Court in *Warner-Jenkinson Co.*, 520 U.S. at 35, placed the importance of the doctrine of equivalents in protecting patent rights on the same plane as literal infringement: [T]here is no basis for treating an infringing equivalent any differently from a device that infringes the express terms of the patent. (Emphasis added).[4] The Court requested the Federal Circuit to "*refine* the formulation of the test for equivalence in the *orderly course of case-by-case determinations*," *id.* at 40 (emphasis added), with no suggestion of a mandate to effectively eliminate the doctrine.

The value of a patent is inextricably linked to the patent owner's ability to enforce it. When the scope of the enforcement rights is substantially narrowed, the value of patent portfolio assets is substantially diminished. In *Festo*, the Federal Circuit has overruled precedents decided as recently as 2000 and potentially reduced the asset base of American businesses by billions of dollars. *See* list of over fifty cases overruled by the majority opinion cited by Judge Michel in his partial dissent. *Festo*, 234 F.3d at 612-615.

Moreover, at least as to the enormous body of patents that remain in force, the financial consequences to industry of the Federal Circuit's decision are unavoidable. Existing patents were prosecuted under very different rules governing

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4. The Court quoted with approval from its decision in *Union Paper-Bag Machine Co. v. Murphy*, 97 U.S. 120, 125 (1878):

> [T]he substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape. *Warner-Jenkinson*, 20 U.S. at 35.

the consequences of amending patent claims than those adopted by the *Festo* majority, and there is nothing that patent owners can do to alter the historical Patent Office records (*i.e.*, the amendments) that will now be invoked to strip owners of valuable and, in many cases, essential enforcement rights. *Id.* at 619 (Michel, J., concurring-in-part and dissenting-in-part) (noting that the majority's abrupt and unpredictable imposition of a complete bar rule breaches faith with all patentees who have rights to an amended claim and who "had no way to avoid the harm that now befalls them"). *Compare Warner-Jenkinson Co.*, 520 U.S. at 41, where the retroactive effect of the much more limited development of a presumption regarding estoppel gave rise to concern in the concurring opinion of Justice Ginsburg, who stated: "The new presumption, if applied woodenly, might in some instances unfairly discount the expectations of a patentee who had no notice at the time of patent prosecution that such a presumption would apply."

B. Copying with Minor Variation Could Proliferate Under The New Rule Announced By The Federal Circuit Majority.

This Court has observed for a century-and-a-half, that literalism has the natural tendency of encouraging competitors to forego significant innovation in favor of the easier, faster, and less costly course of copying a successful invention with minor changes. *See, e.g., Graver Tank*, 339 U.S. at 607 (1950). The Court has also expressed concern that free-riding on another's investment is inconsistent with a well-functioning competitive market. *See, e.g., Monsanto Co. v. Spray-Rite Serv. Corp.*, 465 U.S. 752, 762-63 (1984); *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 480 (1974). As Judge Rader noted in dissent, the Federal Circuit's severe

limitation on the doctrine of equivalents elevates form over substance and will encourage would-be competitors to rely upon minor variations to avoid the reach of existing patents, with particularly troubling consequences in rapidly developing technology fields:

> [B]y barring all application of the doctrine of equivalents for amended claims, this court does not account at all for the primary role of the doctrine. All patent protection for amended claims is lost when it comes to after-arising technology, while the doctrine of equivalents will continue to accommodate after-arising technology in unamended claims. *Festo*, 234 F.3d at 619 (Rader, J., concurring-in-part and dissenting-in-part).

The rule announced by the *Festo* majority facilitates copying of an invention because an infringer can review a patent prosecution history, identify an amended limitation, and then make a trivial change to attempt to bring the product outside of the literal meaning of the amended claim limitation. *Id.* at 616-617 (Michel, J., concurring-in-part and dissenting-in-part).

This Court possesses and has exercised ultimate authority for the interpretation and enforcement of the nation's constitutionally-grounded patent laws. Given the fundamental policy interests at stake, the divided views in the Federal Circuit, and the apparent departure from this Court's precedent, the business community as a whole would benefit from a full and final disposition of the issues presented in *Festo* by this Court.

II. THE FEDERAL CIRCUIT DECISION WILL ENCOURAGE CHANGES IN PATENT PROSECUTION PRACTICES THAT WILL GREATLY AFFECT BOTH APPLICANTS AND THE PATENT OFFICE.

Another predictable consequence of the new rule imposed by the court below will be the imposition of additional administrative burdens on the Patent Office as applicants resort to expensive and time-consuming strategies in an attempt to minimize the rule's impact.

Because applicants must assume no future reliance on the doctrine of equivalents in enforcement proceedings if virtually *any* amendment is made to a claim during the application process, they will strive to secure unamended claims. To this end, applicants first will be encouraged to file numerous, separate applications for the same invention with claims of increasing breadth to enhance the prospect of allowance without amendment. *Second*, the drafting process will be encumbered by attempts to cover by literal language every known, conceivable equivalent, a task that can be more or less daunting depending upon numerous factors that are beyond the applicant's control. For example, as Judge Michel noted in dissent, in the rapidly developing area of biotechnology patents, an applicant's attempt to adequately protect its innovation by writing a literal claim will "put[] an impossible burden on both the applicant and the PTO." *Id.* at 617. Indeed, it is precisely because of concerns that the written word may not completely capture the essence of an invention or anticipate future changes in technology that the doctrine of equivalents has been a part

of patent law since the 19th century.[5] *Third*, under the new rule applicants will have a much greater incentive to appeal any amendments proposed by the PTO during the examination process because of the substantial loss of substantive rights that virtually any amendment now threatens.

The inevitable, if unintended, consequences of the decision below on the already burdened Patent Office may be to force patent applicants to resist an Examiner's proposals for an amendment of a claim, rather than work to compromise with the Examiner on claim language. Without a massive infusion of new resources, the patent application process may well be prolonged, thus depreciating the value of patentable inventions now protected for only twenty years from the filing date. These consequences also support review by this Court.

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5. In recognition of the futility of trying to predict all equivalents during the patent process, this Court ruled in *Warner-Jenkinson*, 520 U.S. at 37, that "the proper time for evaluating equivalency — and thus knowledge of interchangeability between elements — is at the time of infringement, not at the time the patent was issued." Because patent claims address with verbal formulations innovations in rapidly evolving, highly complex technology fields, and must describe the invention in one sentence (Manual of Patent Examining Procedure § 608.01(m) (7th ed. 1998)), it is difficult to overstate the importance of the doctrine of equivalents to an equitable regime of patent protection and enforcement.

III. THE FEDERAL CIRCUIT HAS SUBSTANTIALLY MODIFIED THIS COURT'S AND ITS OWN PRECEDENT WITH ONLY LIMITED EXPLANATION.

A. The Federal Circuit's Curtailment Of The Doctrine Of Equivalents Departs From This Court's Precedents And Scores Of Federal Circuit Precedents.

Judge Michel's dissent below, highlighted the difficulty of squaring the Federal Circuit's curtailment of the doctrine of equivalents with settled Supreme Court authority[6] and the

6. Many Supreme Court decisions follow a rationale that is contrary to the newly announced rule. *See Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222 (1880) (stating in *dictum* that an amended claim could be infringed by an equivalent); *Hurlbut v. Schillinger*, 130 U.S. 456 (1889) (applicant disclaimed by reissue a method of arranging concrete pavement blocks wherein nothing was inserted between the blocks, and the Court held that a trowel used to separate the blocks infringed the claim requiring the use of tar paper or its equivalent between the blocks); *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886) (claim to a skirt protector was amended, but the Court inquired of the accused product "whether an omitted part is supplied by an equivalent device or instrumentality"); *Sutter v. Robinson*, 119 U.S. 530, 541 (1886) (claim was amended to require the use of a wooden, rather than metal, vessel, but Court still considered whether accused devices met limitation by equivalence); *Phoenix Caster Co. v. Spiegel*, 133 U.S. 360 (1890) (claim to a furniture caster had been amended in several respects, but the Court still determined that "there is not in the Yale caster any equivalent" to the amended limitation); *Royer v. Coure*, 146 U.S. 524, 531 (1892) (process claim was amended, but the Court approved of examination of the accused process to determine whether it followed

(Cont'd)

Federal Circuit's own precedent on prosecution history estoppel. Prior to *Festo*, the Federal Circuit itself recognized that this Court's precedents "do[] not necessarily limit a patentee to the literal language of the amended element — even when an amendment has been made to overcome the prior art." *Litton Sys. Inc.*, 140 F.3d at 1455-1456; *Hughes I*, 717 F.2d at 1362 ("We, *as has the Supreme Court*, reject that view [confining amended claims to their literal terms] as a wooden application of estoppel, negating entirely the doctrine of equivalents. . . .") (emphasis added). In fact, the majority's decision in *Festo* expressly overrules at least 52 Federal Circuit decisions handed down between the establishment of that Court in 1982 and the year 2000. *Festo*, 234 F.3d at 613-615 (Michel, J., concurring-in-part and dissenting-in-part).

B. The Federal Circuit's Decision To Curtail The Doctrine Of Equivalents Is A Departure From *Stare Decisis* Which Requires Special Justification.

The Federal Circuit's departure from controlling Supreme Court precedent and its express overruling of 18 years of Federal Circuit precedent was controversial and

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"substantially the same process."); *Hubbell v. United States*, 179 U.S. 77 (1900) (A claim to a bullet cartridge was amended repeatedly, but in examining the accused product the Court considered "whether an omitted part is supplied by an equivalent device or instrumentality."). In all of these cases the Court examined whether an accused product contained an amended claim limitation by equivalence, an inquiry that would have been unnecessary if the rule of the majority below — completely barring any equivalence when a claim limitation is amended — applied.

demanded the compelling foundation normally required for abandoning principles of *stare decisis*. As this Court recently observed in refusing to overrule *Miranda v. Arizona*, 384 U.S. 436 (1966):

> Whether or not we would agree with *Miranda's* reasoning and its resulting rule, were we addressing the issue in the first instance, the principles of *stare decisis* weigh heavily against overruling it now. . . . While " '*stare decisis* is not an inexorable command.' " *State Oil Co. v. Khan*, 522 U.S. 3, 20 (1997) (quoting *Payne v. Tennessee*, 501 U.S. 808, 828 (1991)), particularly when we are interpreting the Constitution, *Agostini v. Felton*, 521 U.S. 203, 235 (1997), "even in constitutional cases, the doctrine carries such persuasive force that we have always required a departure from precedent to be supported by some 'special justification.' " *Dickerson v. United States*, 120 S. Ct. 2326, 2336 (2000).

Long-standing precedent may be overruled when "governing decisions are unworkable or badly reasoned," when facts and circumstances have changed, or when intervening precedent has eroded the original rule. *See, e.g., United States v. International Bus. Mach. Corp.*, 517 U.S. 843, 856 (1996). By contrast, a rule like the doctrine of equivalents — which has been a cornerstone of the common law of patents and the expectations of patent owners for 150 years — should not be sharply curtailed without a compelling rationale.

Although the majority below acknowledged that it was overruling long-standing precedent and expressed awareness

of "the Supreme Court's teaching that binding precedent is not lightly to be discarded," it did not offer any detailed rationale or changed circumstances in support of its decision. *Festo*, 234 F.3d at 575. It did note that its "decision to reject the flexible bar approach . . . comes after nearly twenty years of experience in performing our role as the sole court of appeals for patent matters," and claimed *without citation to any authority* or study that "[the] problem with the flexible bar approach is that it is virtually impossible to predict before the decision on appeal where the line of surrender is drawn." *Id.* While thus concluding that applying the doctrine of equivalents to amended claim limitations was "unworkable," *id.*, the majority gave little scrutiny to the retroactive consequences that would inure to existing patent owners as a result of its decision, the fortuity of tying the loss of valuable patent rights to the mere existence of any claim "amendment," the impact on innovation, and the offsetting administrative burdens that will fall upon the PTO because of the sweeping estoppel regime imposed by the new rule.

C. Any Revision Of Core Patent Rights Might Best Be Left To Congress.

In *Warner-Jenkinson Co.*, this Court made clear that the history of the doctrine of equivalents compels the conclusion that any attempt to abandon the doctrine is properly left to Congress:

> [T]he lengthy history of the doctrine of equivalents *strongly* supports adherence to our refusal in *Graver Tank* to find that the Patent Act conflicts with that doctrine. Congress can legislate the doctrine of equivalents out of existence any time it chooses. The various policy arguments

> now made by both sides are thus best addressed to Congress, not this Court.

Id. at 28 (emphasis added); *cf. United States v. Texas*, 507 U.S. 529, 534 (1993) (noting "presumption favoring the retention of long-established and familiar principles, except when a statutory purpose to the contrary is evident") (citation omitted).

While the policy concerns expressed by the *Festo* majority should be considered if supported by empirical evidence, the Federal Circuit may not be the appropriate forum for making final policy judgments involving doctrinal changes that go to the core of patent protection and have far-reaching implications throughout American industry. If, as the majority held, the interplay of the doctrine of equivalents and prosecution history estoppel requires fundamental re-examination, Congress could conduct the necessary economic studies, hear the concerns pertinent to affected industries, weigh the policy arguments, and assess how best to foster both continued technological advancement and vigorous competition in the national interest. Moreover, by amending existing patent legislation, Congress could balance competing interests, address retroactivity and implement policy judgments with far more precision than a court exercising its common law powers. In the case of amended claims, policymakers may well conclude that the alleged difficulty of having to decide close issues of what was "actually surrendered" can be cured by an approach less draconian than *Festo* which preserves the historic values of the doctrine of equivalents, protects the legitimate settled expectations of existing patent holders and avoids imposing additional administrative burdens on the Patent System.

CONCLUSION

Amicus Curiae The Chamber of Commerce of the United States of America respectfully submits that *certiorari* should be granted to resolve the important issues raised by this case.

Respectfully submitted,

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